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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,195	04/22/2004	Marcia Buiser	01194-459001	7713
26161	7590	06/02/2010		
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER SCHLIENTZ, LEAH H	
			ART UNIT 1618	PAPER NUMBER
			NOTIFICATION DATE 06/02/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

### Office Action Summary

**Application No.**

10/830,195

**Applicant(s)**

BUISE ET AL.

**Examiner**

Leah Schlientz

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 11, 23-31, 49-53, 60, 62 and 63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 23-31, 49-53, 60, 62 and 63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/26/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgement of Receipt***

Applicant's Response, filed 2/26/2010, in reply to the Office Action mailed 12/9/2009, is acknowledged and has been entered. Claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 are pending and are readable upon the elected invention and are examined herein on the merits for patentability.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive, for reasons set forth hereinbelow.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen *et al.* (US 6,530,934) and Greene (US 2002/0177855), in view of Lanphere *et al.* (US 2003/0185895), for reasons set forth in the previous Office Action.

Applicant argues on pages 6-7 of the Response that the obviousness rejection is improper because the Examiner has not demonstrated that the asserted combination of Jacobsen, Greene and Lanphere would have enabled one skilled in the art to make the subject matter covered by the claims. Applicant asserts that applicable case law clearly states that "in order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method." Applicant argues that neither Jacobsen or Lanphere even disclose a process for joining particles, and the process disclosed by Greene would not work for the claimed subject matter, at least because the claimed subject matter requires the link and particles to be integrally formed of the same material.

This is not found to be persuasive. Jacobsen specifically teaches that the beads may be integrally formed of the material of the filament (column 4, line 24), and teaches polymer as a suitable material of both bead and filament, and also teaches porous particles. See also claim 25 of Jacobsen. Greene teaches that both the carrier and the micropellets may be made of PVA (see paragraphs 0093 and 0088). With regard to Applicant's argument that Jacobsen does not teach a process for joining particles, it is noted that a US patent is presumed to be operable/enabling per MPEP 2121. When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). In addition, under 35

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U.S.C. 282 a patent shall be presumed valid (i.e. and thus is presumed to meet the enablement requirement). The Jacobsen patent discloses and claims that filament and bead are integrally formed. The instant claims include the limitation that the particles and link are integrally formed. Absent evidence to the contrary, it is presumed that one of ordinary skill would have been able to provide integrally formed polymeric particles/beads on a polymeric filament, as disclosed and claimed by Jacobsen. It is noted that the instant claims are product claims, not method of making claims.

### ***Double Patenting***

Claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 7,131,997; 7,449,236; 7,462,366; 7,588,780 and 7,611,542 in view of Jacobsen *et al.* (US 6,530,934) and Greene (US 2002/0177855), for reasons set forth in the previous Office Action.

Claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Application Serial No. 12/235,978, 12/236,051 and 10/651,475 in view of Jacobsen *et al.* (US 6,530,934) and Greene (US 2002/0177855), for reasons set forth in the previous Office Action.

Applicant argues on page 7 of the Response that in view of the above arguments, withdrawal of the rejection is requested.

This is not found to be persuasive, for reasons set forth above.

***Conclusion***

No claims are allowed at this time.

Although Applicant's arguments as set forth in the aforementioned Response have been fully considered, they are deemed unpersuasive. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leah Schlientz whose telephone number is (571)272-9928. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday 9 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/  
Supervisory Patent Examiner, Art Unit 1618

LHS